



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/770,874

01/26/2001

Samuel Dinkin

YOR920000312

6668

(1963-5014)

7590

04/25/2006

EXAMINER

SUBRAMANIAN, NARAYANSWAMY

WHITHAM CURTIS CHRISTOFFERSON PC
11491 SUNSET HILLS ROAD
SUITE 340
RESTON, VA 20190

ART UNIT

PAPER NUMBER

3624

DATE MAILED: 04/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/770,874

Applicant(s)

DINKIN ET AL.

Examiner

Narayanswamy Subramanian

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-5,9,11,16,18,19,31,33,34,46,48-50,54,55 and 60 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-5,9,11,16,18,19,31,33,34,46,48-50,54,55 and 60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to applicants' communication filed on December 9, 2005. Rejections of claims under 35 U.S.C. 112, second paragraph made in the last office action have been withdrawn in view of the amendments. Claims 1, 3-5, 9, 11, 16, 18, 19, 31, 33, 34, 46, 48-50, 54, 55 and 60 are currently pending and have been examined. The rejections and response to arguments are stated below.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 46, 48-50, 54, 55 and 60 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory Subject matter. The claimed invention drawn to these claims is inoperative and therefore lacks utility.

Claims 46, 48-50, 54, 55 and 60 merely recite a machine readable medium containing a computer program for fulfilling at least one need, without showing any ability to realize functionality of the recited elements (i.e. functional descriptive material per se) and therefore is rendered inoperative lacking any utility. Note that a computer (or software program) code cannot by itself perform the underlying function until it is loaded on some computer readable memory and accessed by the computer (or a processor).

Functional descriptive material, per se, is not statutory. This is exemplified in *In re Warmerdam* 31 USPQ2d 1754 where the rejection of a claim to a disembodied data structure was affirmed. Thus a claim to a data structure, per se, or other functional descriptive material, including computer programs, per se, is not patent eligible subject matter.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 3-5, 9, 11, 16, 18, 19, 31, 33, 34, 46, 48-50, 54, 55 and 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sibley Jr. (US Patent 4,677,552).

Claims 1, 16, 31 and 46, Sibley discloses a method, a data processing system and a machine readable medium containing a computer program for fulfilling at least one need, the method comprising: receiving at least one request for a product or service (See Sibley Col 9 lines 58-67); identifying, using a computer or network, a plurality of markets (See Sibley Col 10 lines 14-42); requesting at least one offer to fulfill said at least one request from at least one entity within said identified markets (See Sibley Col 2 lines 23-34); and communicating at least a portion of offers received in response to said requesting step to a party making the at least one request (See Sibley Col 2 lines 34-55). The phrase “capable of” is not a positive limitation, claim limitations that employ phrases such as “adapted to” or “in order to” “for” or “capable of” to do some thing may not distinguish over prior art. It has been held that the recitation that an element is “adapted to” or “capable of” performing a function is not a positive limitation but only requires the ability to so perform. Hence these elements of the claim are not given patentable weight. A data processing system and a machine readable medium containing a computer program for performing the above steps are inherent in the disclosure of Sibley.

Claims 3-5, 9, 11, 18, 19, 33, 34, 48-50, 54, 55 and 60, Sibley discloses facilitating a transaction between said party making the request and at least one of said at least one entity within said plurality of markets identified in said identifying step (See Sibley Abstract , Col 1 line 59 – Col 2 line 54); the identity of said party making the request is withheld for a period of time from said at least one entity within said plurality of markets identified in said identifying step (See Sibley Col 1 lines 32-35); said offers are made through at least one of an open auction; a sealed auction; a series of negotiations; and a posting of a price (See Sibley Col 11 line 60 – Col 12 line 2); offers are offers for exchange of goods or services (See Sibley Col 3 lines 35-65); said communication of at least a portion of said offers includes at least one of: an offered price; a description in terms of quality of what is being offered; a description sufficient to identify what is being offered; a description in terms of reliability of said at least one entity within said plurality of markets identified in said identifying step; and a solution to fulfillment of said request (See Sibley Col 11 line 60 – Col 12 line 2); code for said identification to be accomplished in part by processing data from a market database (See Sibley Col 5 line 60 – Col 6 line 22).

Response to Arguments

6. Applicant's arguments with respect to pending claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

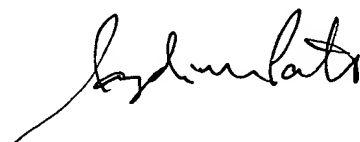
7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is (571) 272-6751. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (571) 272-6747. The fax number for Formal or Official faxes and Draft to the Patent Office is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PMR or Public PAIR. Status information for unpublished applications is available through Private PMR only. For more information about the PMR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dr. N. Subramanian *NS*
February 16, 2006


JAGDISH N. PATEL
PRIMARY EXAMINER